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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1966

No. 432

GEORGE O. GRAVES, d/b/a MICHIANA MILLS,
Petitioner,

vs.

KELL-DOT INDUSTRIES, INC., EDWIN F. KELLEY and MANLEY, INC.,
Respondents.

BRIEF FOR RESPONDENTS

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BRIEF FOR RESPONDENTS

This brief is filed on behalf of respondents in opposition to the Petition of George O. Graves, d/b/a Michiana Mills, for a writ of certiorari to the United States Court of Appeals for the Eighth Circuit to review the judgment of that court adverse to petitioner. The court below reversed the decision of the District Court which had held petitioner's patent valid and infringed by a food processing machine manufactured, used and sold by respondents.

OPINIONS BELOW

The opinion of the District Court, including the findings of fact and conclusions of law (App. A of Petition, a printer's error designating the trial judge as "Ginn" rather than "Gibson") is reported at 229 F. Supp. 143. The opinion of the Court of Appeals for the Eighth Circuit is set out at App. B of Petition.

JURISDICTION

The jurisdictional requisite is adequately stated in the Petition.

QUESTION PRESENTED

Whether or not the Court of Appeals for the Eighth Circuit, in holding the petitioner's patent invalid, followed and employed the applicable constitutional and statutory standards of patentability.

CONSTITUTIONAL PROVISIONS, STATUTES AND RULES INVOLVED

The applicable constitutional provision is Article I, Section 8, Clause 8. The applicable statutes (set out at p. 3 of the Petition) are 35 U.S.C., Sections 101 through 103 and 282. Rule 19 of the rules of this Court, 347 U.S. Appendix, 28 U.S.C.A. (Supp.) and Article I, Section 8, Clause 8 of the U. S. Constitution are also involved.

STATEMENT

In its review and reversal of the decision of the District Court, and in holding petitioner's patent invalid, the Appellate Court carefully considered the lower court's findings of fact and noted particularly that he had found the "invention" of the patent claims to be limited to the use of but a single headplate (Pet. A-15,

16). That finding (Pet. A-2, 10) resulted from the following representations made to the court at the trial by the petitioner:

> "The Court: Let me ask the plaintiff in this case, there isn't any contention is there that the device set up in the patent in question, -072, is different from the device set up in patent -927 in any element except the extrusion plate?
>
> "Mr. Hobbs: The crux of the invention is in the extrusion plate. Now, the extrusion plate, however, cannot be isolated from the rest of the structure. In other words, it forms an operative combination, and the claim so defines it so that the extrusion plate is in combination with the internal bore occupied by the helical ridge.
>
> "The Court: The Court appreciates the rest of it has to be there to complete the operation. But I mean there isn't any contention that the other elements that are present in -927 are not present in -072—
>
> "Mr. Hobbs: That is right.
>
> "The Court: —with the exception of the single extrusion plate?
>
> "Mr. Hobbs: You are correct on that, Your Honor.
>
> "Mr. Schmidt: I would like to ask whether or not this would be a stipulation, whether or not plaintiffs are contending that there is a difference in their invention in eliminating one more head plate from the -927 per se.
>
> "The Court: I took it that was their position.
>
> "Mr. Hobbs: That is the crux of the invention.
>
> "Mr. Schmidt: The crux of the invention? Instead of using two head plates, the use of one—

"Mr. Hobbs: In addition to the other elements in there. It is correct that the one head plate in combination with the other elements—

"The Court: That was the Court's understanding of the situation altogether.

"Mr. Schmidt: The use of one head plate instead of two?

"The Court: Yes." (R. 312, 313).*

Petitioner is named as the co-inventor in the G and R prior art patent No. 2,705,927 (R. 55) showing a collet extrusion machine having a number of headplates 74, 76, 78 with extrusion holes 82, 86, 88 (RX-48, 153, 154). In the commercialization of such machines (R. 161) petitioner testified that he used two headplates (R. 57, 62), his sketches thereof showing extrusion holes 82, 82A, 86, 86A (RX-49, 50). Petitioner conceded (R. 55-64) and the Appellate Court found the shape and configuration of the extrusion holes of the two prior art headplates, and others (RX-X; R. 287-289) to be the same as the holes 60, 62 of the single headplate 26 (RX-147) of petitioner's patent 2,842,072 in suit (Pet. A-17). Moreover, the Appellate Court made special note of petitioner's admission that "there is no novelty in the shape or configuration of the element", *i.e.*, "the configuration of the single head plate" (Pet. A-20).

The Trial Court ruled, therefore, "that all of the components of plaintiff's (petitioner's) machine are components which were present in prior patented food processing machines with the exception of the single stage single headplate" (Pet. A-7). The Appellate Court said

*The numerals "-072" above refer to petitioner's patent No. 2,842,072 in suit, and the numerals "-927" above refer to a prior art patent No. 2,705,927, called the "G and R patent."

that "what is important is that plaintiff's (petitioner's) machine explicitly follows the prior art found in the G & R patent with the sole exception of utilization of a single extrusion head plate" (Pet. A-18).

Petitioner admits the similarity of the product produced by the prior art with that produced by the machine of his patent in suit (Pet., p. 4) but fails to point out that in actuality the products were identical in nature and in quality, by petitioner's own admission (R. 183). The Appellate Court ruled accordingly (Pet. A-17).

Petitioner also made it clear at the trial that the "invention" of his patent in suit did not lie in the prebaking of the product. He admitted that in the prior art machines which he used commercially (a) "the temperature (was) sufficiently high to vaporize the moisture in the mixture"—(b) "to prebake the material"—(c) "sufficiently to render it relatively brittle" (R. 196). Such admissions—"that the older machines prebaked the material", and "that the holes in the head plate were used in 1952 and that the G & R machine prebaked the material before expulsion", were duly referred to in the decision of the Appellate Court (Pet. A-20).

Petitioner (the inventor himself) was convinced (and he so convinced the Trial Court), and it was his own personal belief that his "invention" was limited to the use of but a single headplate. The Trial Court found that such use "substantially simplifies the operation and cleaning of the food processing machine" (Pet. A-7). The Appellate Court also noted but rejected petitioner's attempt "to bolster his position by extravagant claims of commercial success, improvement eliminating employment of skilled personnel and greater production speed" (Pet. A-20).

ARGUMENT

1. Appellate Court fully considered and properly treated all portions of each claim of petitioner's patent.

Petitioner's proposition that the Appellate Court failed to consider the claims of his patent cannot operate as a reason for granting a writ of certiorari herein because it is contrary to fact. More specifically, petitioner argues that a certain italicized portion (Pet. 12) of the patent claims was disregarded. That portion of the claims refers to the extrusion holes of the headplate and speaks of their size, *i.e.*, area and length such as to "raise the temperature of the meal" and thereby "prebake" it.

As above pointed out, the Appellate Court said:

> "* * * it is admitted that the older machines prebaked the material and there is no novelty in the shape or configuration of the element. Plaintiff admitted that the holes in the head plate were used in 1952 and that the G & R machine prebaked the material before expulsion" (Pet. A-20).

We submit that this treatment by the court below of the subject matter of petitioner's proposition fully nullifies it as a reason for granting the writ. Moreover, it is clear that the Appellate Court read the record because no similar reference to petitioner's admissions was made by the Trial Court in his decision and findings (Pet. A1-A11). Rather than merely review the opinion of the District Court, the Court of Appeals went to the record itself and predicated its conclusions as to the italicized portion of the claims precisely upon the position of the inventor himself. Again, as above set forth, petitioner conceded that in the prior art machines:

(a) "the temperature (was) sufficiently high to vaporize the moisture in the mixture",

(b) "to prebake the material",

(c) "sufficiently to render it relatively brittle".

Now, it is also clear that petitioner was forced to make such admissions because he had previously conceded the identity of the single headplate with those he had previously used in the prior art G & R machines (R. 55-64). He had even sketched out the shape of the holes of the old plates (RX-49, 50) and demonstrated their identity with the headplate shown in his patent in suit. The Appellate Court had no choice other than to find that "plaintiff admitted the holes in the head plate were used in 1952 * * *" (Pet. A-20).

It follows then that the description in the patent claims of the single headplate is also a description of the prior art headplates. The italicized language of the patent claims, which describes the extrusion holes, also describes the holes of the prior art plates. The recitation therein that the holes "raise the temperature of the meal" is exactly what happened (as petitioner admitted) in the holes of the old plates. Raising the temperature of the meal high enough to "prebake the meal", as called for by the italicized portion of the patent claims, was admittedly done when the old plates were placed in use.

Furthermore, the presentation made by petitioner in an effort to support his contention that a writ of certiorari should be issued herein constitutes a complete change of position from the representations which he made to the lower courts. Having the burden of proving infringement, he was forced to have the patent claims interpreted as broadly as possible. In this he succeeded by convincing the Trial Court that his invention was

solely the substitution of one for a number of headplates.

On that basis then, any such machine using a single headplate would infringe regardless of the size, number or configuration of its extrusion holes, and the fact that in the accused machine the bore, the screw in the bore, the cut-off knife, and all other components were old and taken directly from the prior art would have no bearing. Even though prebaking and the end product were admittedly old, and in spite of the fact that the nature of the single headplate was not new, petitioner was able to persuade the Trial Court to find infringement solely because the accused machine used but a single headplate.

However, now, in his petition, this inventor speaks of "the unpatentable and broader concept of merely the use of a single headplate * * *" (Pet. 17), in contrast to his earlier position that "the crux of the invention is in the extrusion plate" (R. 312), which purposely left the Trial Court with the understanding that the invention was "the use of one head plate instead of two" (R. 313).

On the other hand, had petitioner taken the position at the trial which he now takes herein (that the mere use of a single headplate is an "unpatentable" concept) it would have been necessary for him to show the Trial Court where, in the claims of his patent, patentable limitations could be found. This he carefully avoided because a narrower interpretation of the claims would place the accused machine outside the realm of infringement.

Petitioner now says that "the basic distinctions over the prior art were set forth in the patent claims by the italicized part of the patent claims quoted hereinabove * * *" (Pet. 17). Had he, at the trial, attempted to differentiate the claims over the prior art to show them to be new

and valid on the basis of certain distinctions, those exact differences would have rendered the accused machine non-infringing.

As a matter of fact, the holes of the headplate of the accused machine are different from those of the headplate shown in the patent and different from petitioner's sketches of the G & R headplates. They have the shape and configuration of the holes of headplates of many other prior art patents. It was essential then to petitioner's charge of infringement that the Trial Court be persuaded to overlook those differences. Petitioner knew that he could not emphasize the italicized portion, or any other detail of his claims in an effort to show a differentiation therein over the prior art. To do so would have nullified his infringement position.

Instead, he took the only course available—convince the Trial Court that the details of the claims were old in the prior art—the invention was the use of a single headplate—the accused machine infringes because it uses a single headplate.

Now, in his petition, this inventor chooses to ignore his own admissions, overlook the fact that the Appellate Court considered his admissions, deny his previous argument that the "invention" is limited to a single headplate, and take a course of action which he dared not take in the lower courts when his infringement contention was at stake.

> "The owner of a patent cannot assert a broad construction of its claims in order to make out a case of infringement and then narrow them so as to avoid anticipation.—*Smith* v. *Hall*, Conn., 57 S. Ct. 711, 301 U.S. 216, 81 L. Ed. 1049— *International-Stacey Corporation* v. *U. S.*, 42 F. Supp. 384, 95 Ct. Cl. 357." 69 C.J.S., 679.

Petitioner's implication that the Appellate Court was unmindful of the fact that it must determine validity of the *claims of his patent* rather than the rejected, cancelled claims of his patent application is negated by the following statement from its decision:

> "Nonetheless, the Supreme Court was convinced that the patent in Calmar must fall when the proper interpretation is made of § 103, since *the differences in the claims of the Calmar (Cook) patent and the pertinent prior art* would have been obvious to a person reasonably skilled in that art." (Pet. A-23) (Emphasis added)

Petitioner's contention that the United States Court of Appeals for the Eighth Circuit disregarded a portion of the language of the patent claims is wholly without basis.

2. The Appellate Court gave full treatment to prima facie validity of petitioner's patent.

Petitioner calls attention to his observation that in the decision of the Appellate Court no direct reference is made, in so many words, to the statutory presumption of patent validity. 35 U.S.C. 282. Upon this observation petitioner bases his contention that the presumption was ignored by the court below. And upon such contention he petitions this Court to review the decision.

The fact that the Appellate Court did not expressly refer to the presumption does not, in any sense, infer that it did not receive proper consideration. One need look no further than the recent decisions of this Court in the Graham and Calmar cases (*Graham et al.* v. *John Deere Company of Kansas City*, 383 U.S. 1, and *Calmar, Inc.* v. *Cook Chemical Company*, 383 U.S. 1) for examples of a reviewing court applying the proper standards of

patentabiilty, giving due consideration to the presumption of validity set out in the statute, without mentioning the presumption in its opinions.

However, petitioner is wrong in charging the Appellate Court with ignoring 35 U.S.C. 282, treating the presumption as a nullity and failing to apply the law of the statute (Pet. 14-18). He is wrong in contending that "a thorough and careful reading of the decision of the Appellate Court fails to reveal any indication whatever that the statutory presumption of validity entered the mind of the Court with respect to the claims in issue in this case" (Pet. 16). Such reading was still not sufficiently "thorough and careful" because petitioner failed, in connection with this point, to call attention to the meaning and effect of the following language of the decision:

> "Nonetheless, plaintiff's patent must be sustained if at all upon the employment of the single head plate. We assume that stripped of its patentise language, the five claims primarily focus attention to the single head plate and do not understand the patent examiner's rejection of more specific claims for this element and final acquiescence when more obscure language was employed. The examiner must have been persuaded by the configuration of the single head plate, but it is admitted that the older machines prebaked the material and there is no novelty in the shape or configuration of the element. Plaintiff admitted that the holes in the head plate were used in 1952 and that the G & R machine prebaked the material before expulsion." (Pet. A-20).

Therefore, what the Appellate Court said, in effect, was that it recognized that the claims in issue had been deemed patentable in the first instance by the U. S. Patent Office. The Court was mindful of the fact that there must have been a reason for allowance and that it

had a duty to give due consideration to the decision of the patent examiner. So it raised the question of why the examiner did what he did and concluded that he "must have been persuaded" by certain factors.

The net result is a full recognition by the Court that it should not merely invalidate the claims on its own volition without first considering the presumption that the patent examiner was right in allowing the claims. Due thought and consideration was given to the file history of the patent application and the prosecution, which included reading and interpreting the allowed claims with reference to the rejected claims and the prior art precisely as is required by this Court (*Calmar, Inc.* v. *Cook Chemical Company*, 383 U.S. 1, 15 L. Ed.2d 545, 565 (1966).

The court below also recognized that the presumption is rebuttable and ruled against patentability of the allowed claims. It is clear from the language of the decision above quoted that the Court was mindful of the fact, while it is true that a patent is *prima facie* valid, the presumption of validity is greatly weakened when defenses relied upon were not known by the Patent Office. Such defenses referred to by the Court include petitioner's admissions that the shape and configuration of the holes had previously been used by him in prebaking (Pet. A-20).

The "statutory presumption of validity" did, therefore, enter "the mind of the Court"; the statute was not "ignored"; there is no "fundamental error" for failure "to apply the law"; and there was no "fundamental oversight by the Appellate Court in the application of the law" as contended by petitioner (Pet. 16, 17).

3. The Appellate Court correctly considered the necessity of non-obviousness as a statutory condition for patentability.

The importance which the Appellate Court attached to the question of obviousness is indicated by the fact that, under a separate section entitled "Recent Teachings of the Supreme Court", it discussed the matter at length (Pet. A-21-23). But petitioner contends that there was still a failure to follow or apply the formula of this Court. That "formula" as defined by petitioner is to determine obviousness in reference to the language of or the invention covered by the patent claims (Pet. A-3, 7).

The Appellate Court fully understood the formula of this Court. It said that in the Calmar case the patent was held invalid because "the differences in the claims of the Calmar (Cook) patent and the pertinent prior art would have been obvious to a person reasonably skilled in the art" (Pet. A-23).

It then proceeded to apply the "formula" in the following manner:

> "We are convinced here that anyone skilled in the art with patent office references before him could have, without the exercise of any inventive faculty, combined old elements known to the art and made plaintiff's machine. Assuming that the patent in suit was an improvement over the prior art, it still does not rise to the level of patentability.
>
> "Mr. Justice Clark, in the preface of his opinion in *Graham, supra,* called attention to the origin and history of the patent law and pointed out that, from its very inception, the granting of patents for small details or obvious improvements has been abhorred. We could not follow the guidance of the Supreme Court without ruling the invalidity of the patent in

suit and would be compelled to do so anyway under the previous rulings of the Supreme Court as well as the decisions of this circuit" (Pet. A-23).

This is, therefore, not a case which involves questions of either fact or of law needing review by this Court. Petitioner contributed nothing to the fund of human knowledge. His machine was almost entirely old. The product it produced was old. The production by preheating was old. Raising the temperature to cause preheating was old. The holes in the headplate were old.

The invention was the removal of one old headplate from an old machine and continuing to use the other old headplate. As pointed out by the Appellate Court, whereas the patentee had many factors in the Calmar case to raise serious doubts as to obviousness, this petitioner had none (Pet. A-22-A-23). The Appellate Court properly held the subject matter of the claims to be obvious in view of the prior art.

CONCLUSION

Rather than present any special or important questions which remain unsettled after this Court's recent decisions in the field of patent law, the Petition merely raises issues which were thoroughly considered by the Court of Appeals in light of those decisions.

It has raised no points about which the circuits are in conflict. It has pointed to no unsettled questions which need determination by this Court. All of petitioner's contentions received consideration below. The patent involved certainly has no great public importance. In short, the Petition totally fails to set forth any "special and important reasons" whatsoever for the grant of certiorari here.

The Petition for certiorari should be denied.

Respectfully submitted,

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